

REMARKS

I. Claim Status.

Claims 1-23 are pending in the application. Claim 23 is amended and claims 1-15 and 17-23 are provisionally elected in the present communication subject to a restriction requirement.

II. Claim Objections

In response to Examiner's objection, incorrectly numbered claim 22 is renumbered as claim 23.

III. Elections/Restrictions

In response to the Restriction Requirement, Applicants traverse the Restriction Requirement on the grounds that (i) the Examiner has not made a *prima facie* case that the inventions are independent and distinct; and (ii) a combined search and examination for combined Restriction Groups I-III would not impose a serious burden on the Examiner.

Under United States patent law, the Examiner must establish that the inventions are independent and distinct for proper restriction. *See*, 35 USC § 121; 37 CFR §§ 1.141-1.142; MPEP §§ 802-803. For the inventions to be independent, there must be no disclosed relationship between the two or more subject matters disclosed, that is, "they are unconnected in design, operation or effect. . ." MPEP § 802.01. According to the MPEP section 802.01, "independent . . . means not dependent." This section goes on to indicate that a combination and subcombinations are dependent. Claims 16 and 17 depend from and contain all of the limitations of Claim 1. Thus Claim 1 provides a linking claim for Claims 16 and 17. In view of the relationship between the claims, and the fact that non-elected Claims 16 and 17 are dependent on Claim 1, there is a disclosed relationship between the subject matter of Groups I-III. Thus, it is submitted that the various groups of claims are not directed to independent and distinct inventions.

In addition to showing that the inventions are independent and distinct, the Examiner must also show a serious burden by showing separate classification, status in the art, or a different field of search. MPEP § 803. All Claims are limited to products

or methods each having a structurally related fluorescent compound, in varying language. The Examiner has not established, *prima facie*, that searching these related claims imposes a serious burden and it is Applicants position that a combined search and examination does not impose a serious burden on the Examiner. Accordingly, withdrawal of the restriction requirement is requested.

Notwithstanding the objection to the Restriction requirement, Applicants provisionally elect group I, Claims 1-15 and 18-23 drawn to a fluorescent compound, without prejudice. Applicant retains the right to pursue the subject matter of non-elected claims 16 and 17 at a future date in this or in another application. In addition, Applicant requests rejoinder of the non-elected claims, where appropriate, should the elected invention be found allowable.

Applicants respectfully submit Examiner's requirement for an election of species is likewise improper. As a preliminary matter, Examiner has not identified the generic claims nor clearly identified the species from which an election is to be made. In response to Examiner's requirement to elect single disclosed species, Applicants traverse on the grounds that (i) the Examiner has not made a *prima facie* case that the species are independent and distinct; and (ii) a combined search and examination for the claimed species would not impose a serious burden on the Examiner.

Examiner's conclusion that "the species are independent or distinct because they have different chemical structure (sic)" is clearly insufficient to support a *prima facie* case that the species are independent and distinct. As set forth in MPEP § 803.02:

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility.

All claims are limited to a Markush-type claim describing a fluorescent reporter compound, which recites alternatives, e.g., to a linker or a cyanine dye, wherein the members of the group possess at least one property in common which is mainly

responsible for their function, e.g. linker or fluorescent label, and it is clear from their very nature or from the prior art that all of them possess this property. Accordingly, the mere fact that members of a Markush group recite different chemical structures is an insufficient basis for finding the species are independent and distinct.

The generic claims of the present application are limited to products or methods each having a structurally related fluorescent compound, set forth in accordance with Markush practice. The Examiner has not established, *prima facie*, that searching these structurally and functionally related compounds imposes a serious burden and it is Applicants position that a combined search and examination does not impose a serious burden on the Examiner. Accordingly, withdrawal of the requirement to elect species is requested.

Notwithstanding the objection to the Election of Species requirement, Applicants provisionally elect the specific structure set forth in Claim 11 for prosecution on the merits. Claims 1-9 and 11-17 are readable on this structure. In addition, Applicants request rejoinder of the non-elected species, where appropriate, should the elected species be found allowable.

CONCLUSION

If there are any issues that can be resolved by telephone with the Applicants' representative, the Examiner is encouraged to contact the undersigned directly.

No fees are believed due with this Response. However, if any fees are due, the Commissioner is authorized to charge any such fees to deposit account No. 19-2090.

Respectfully Submitted,
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